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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/747,622   | 12/30/2003  | Frederick A. Enko    | 06181-930001        | 2901             |
| 26171  | 7590        | 02/24/2005           | EXAMINER            |                  |
| FISH & RICHARDSON P.C.<br>1425 K STREET, N.W.<br>11TH FLOOR<br>WASHINGTON, DC 20005-3500 |             |                      | JOHNSON, JERROLD D  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3728                |                  |

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                    |
|------------------------------|-----------------|--------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)       |
|                              | 10/747,622      | ENKO, FREDERICK A. |
|                              | Examiner        | Art Unit           |
|                              | Jerrold Johnson | 3728               |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 June 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) 8-10, 14 and 15 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7 and 11-13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-15 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a puzzle storage device, classified in class 206, subclass 315.1.
- II. Claims 14-15, drawn to method for storing a puzzle, classified in class 53, subclass n/a.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used as a beach pillow/mat.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1: straps, hook and loop fasteners, and elastic loops; Species 2: bag; Species 3: snaps; Species 4: zipper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-5 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with John Hayden on 8 February 2005 a provisional election was made without traverse to prosecute the invention of Group I, Species 1, claims 1-7 and 11-13. Affirmation of this election must be made by applicant

in replying to this Office action. Claims 8-10,14 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

Claims 1,2,12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan US 5,966,757.

With respect to claim 1, Sullivan 1discloses a device inherently capable of being used for puzzle storage comprising:

a puzzle assembly mat; and

an inflatable tube around which a puzzle assembly mat may be rolled.

Please note extrinsic evidence 5,375,707, which shows how a puzzle can be rolled around a tubular element for storage.

With respect to claim 2, the inflatable tube is attached to an end of the puzzle assembly mat.

With respect to claim 12, the puzzle assembly mat comprises a rough surface (the towel surface).

With respect to claim 13, the puzzle assembly mat comprises a plastic or vinyl sheet and the rough surface comprises a flocked surface (the towel).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan 5,966,757 in view of Roberts US 6,131,219.

Sullivan discloses the claimed invention with the exception of multiple inflation chambers within the inflatable tube, (his pillow).

Roberts teaches the use of multiple chambers in a pillow so as to provide specific support characteristics to the pillow.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the inflatable tube of Sullivan with the teachings of Roberts so as to provide a better supporting pillow.

Claims 4-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan 5,966,757 in view of Sullivan US 6,182,309.

Sullivan 5,966,757 discloses the claimed invention with the exception of a mechanism to secure the puzzle assembly mat around the inflatable tube.

Sullivan US 6,182,309 teaches the use of straps comprising elastic loops for securing a mat around a tube. The benefits of the straps are greater ease of portability of the towel/pillow device.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the mat and inflatable tube of Sullivan 5,966,757 with the teachings of Sullivan 5,966,757 so as to provide a more easily transported device.

With specific respect to claim 7, hook and loop fasteners are considered an art recognized equivalent to the straps and elastic loops previously rejected, and are rejected for the reasons stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

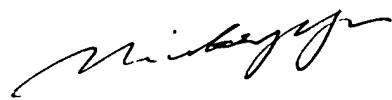
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JDJ



Mickey Yu  
Supervisory Patent Examiner  
Group 3700